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Date: November 23, 2009

By /Jennifer Archer/
Jennifer Archer

Docket No. 101769-254 KGB
Confirmation No. 8156

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Ralf SCHLIEPHACKE et al
SERIAL NO. : 10/830,172
CUSTOMER NO. : 27384
FILED : April 21, 2004
FOR : METHOD FOR DIECUTTING A WEB WHICH IS PROVIDED
WITH ADHESIVE AT LEAST ON ONE SIDE AND IS ON A
BACKING MATERIAL INTO INDIVIDUAL DIECUTS
ART UNIT : 1791
EXAMINER : James Sells

November 23, 2009

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicants respectfully request pre-appeal brief review of *all* of the rejections made in the final rejection mailed on June 22, 2009, all of which are based on Khatib, US 5,370,420, in view of Treleaven, US 6,413,345.

A Notice of Appeal and a Petition for a Two Month Extension of Time are submitted along with this paper.

I. The Examiner errs in failing to acknowledge the unexpected results demonstrated by the data in the instant specification.

Applicants refer to the Summary of the Claimed Subject Matter at pages 2-4 of the Appeal Brief filed August 6, 2008.

Applicants also refer to the discussion of unexpected results under point II at pages 8-12 of that same Appeal Brief filed August 6, 2008.

The present invention relates generally to a process whereby a substrate is diecut into multiple individual diecut pieces. In the prior art, this diecutting typically occurred along a *straight* line. The method of instant claim 1 specifically requires that the diecutting line is “a nonbranching line having a form other than that of a straight line.”

When the resulting diecuts are dispensed from a device, for example, the dispensing device shown in Figure 7, Applicants have discovered that diecuts cut with a non-straight line offer an unexpected advantage in terms of the speed with which they can be dispensed. As discussed in the instant specification at page 10, lines 25 ff, the maximum rate that diecuts cut with a *straight* line can be dispensed is 0.3 m/s. In contrast, the maximum rate that diecuts cut with a *non-straight* line can be dispensed is unexpectedly much greater, i.e., *2.0 m/s—nearly 7 times faster!*

There is nothing in the cited combinations of references that teaches or suggests that the nature of the diecutting line is a result-effective variable affecting the dispensing rate of the resulting diecuts.

There is also nothing in the cited combination of references that teaches or suggests that a non-straight diecutting line should produce diecuts that can be dispensed at a much faster rate than diecuts produced by a straight diecutting line.

Consequently, either way, the data in the instant specification evidence an unexpected result, which is objective evidence of nonobviousness.

The Examiner errs in failing to acknowledge these unexpected results.

2. The Examiner errs in finding that the unexpected results are taught in the prior art, specifically, Scholz, US 2002/0041945.

The Examiner relies on Scholz's paragraph [0056] to teach "[f]eeding/dispensing diecut materials at a rate in the range recited in applicant's claims is known in the prior art * * *. Therefore applicant's argument is not persuasive in this instance." See the first paragraph on page 6 of the final rejection.

However, Applicants respectfully point out that Scholz's paragraph [0056] mentions his constructs "are capable of being converted by *diecutting* and *matrix-stripping* at high speeds, e.g., at web speeds of about 0.75 m/s (150 feet per minute), and in some cases up to about 1.5 m/s (300 feet per minute)." "Diecutting" refers to the process of cutting the diecuts into the substrate. "Matrix-stripping"¹ refers to the removal of extraneous material from around the cut diecuts after the diecutting is done. Accordingly, nowhere does Scholz discuss the result that Applicants claim to be unexpected, i.e., the improved speed of dispensing the diecuts from a dispensing device, for example, as shown in Figure 7.

Further, Scholz's general statements are irrelevant in any event in the face of the actual comparison data. Once again, the instant data show that a maximum dispensing speed of 0.3 m/s is obtainable with straight line produced diecuts, whereas 2.0 m/s is obtainable with non-straight line produced diecuts. Nothing in Scholz teaches or suggests this difference in results. There is no reason, even given Scholz's general statements, to expect that it should be possible to dispense diecuts produced by diecutting along a non-straight diecutting line significantly faster than to dispense diecuts produced by diecutting along a straight diecutting line. Accordingly, the instant comparative data must still be regarded as surprising and, therefore, unexpected, even in view of Scholz's general statements, and, further, as objective evidence of nonobviousness.

The Examiner errs in not acknowledging the demonstrated results to be unexpected in

¹ Further information on the overall matrix-stripping process can be found in Reed, US 4,246,058, if desired.

view of the cited prior art.

3. The Examiner errs in refusing to allow the claims because the unexpected results are not recited in the claims themselves.

The Examiner has consistently refused to issue the instant claims at least in part because the unexpected results are not recited in the instant claims. Applicants have consistently directed the Examiner to the decision in *In re Merchant*, 197 USPQ 785, 788 (CCPA), for the proposition that the claims need *not* recite the unexpected results of a process so long as the structural features responsible for the unexpected results are recited in the claim. See, for example, pages 6 and 7 of the amendment filed February 24, 2009.

In the second paragraph on page 6, the Examiner attempts, but utterly fails to distinguish the *Merchant* decision. First, the Examiner says that “all of the method steps applicant alleges produce unexpected results are known in the prior art.” This position is untenable. A *prima facie* case of obviousness could not exist in the first place were all the steps of a claimed method not taught or suggested by the prior art. And, the fact that they may all be in the prior art is no reason to ignore and/or fail to give proper weight to comparison data that rebuts the presumption of obviousness.

The fact of the matter is that even if all of the steps were known in the prior art—which Applicants do not concede—they have not been combined in the prior art in the manner that Applicants claim. Thus, the rejection is one for obviousness, not anticipation. Moreover, the Examiner has not shown there to be any expectation in the art of the improvement that Applicants have demonstrated. So, at best, the Examiner has established a *prima facie* case of obviousness based on a *hypothetical* combination of known steps, which *prima facie* case of obviousness has been rebutted by comparison data showing an unexpected result obtained when the steps were combined *in actuality*.

Second, the Examiner says “the specific results applicant alleges are unexpected are also known to the prior art (see Scholz as described above).” As noted above, Scholz refers to diecutting and matrix-stripping speeds, not to the speed of dispensing from a dispensing device,

which is the improvement demonstrated in the instant application.

The Examiner errs in continuing to ignore *Merchant* and to find it inapplicable to the instant fact situation.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the final rejections and allowance of claims 1-6.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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